



APAP31191-A 072852.0117
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant : Seo Hong Yoo
Serial No. : 09/778,154 Examiner : Kim, Vickie
Filed : February 5, 2001 Group Art Unit : 1615
For : PREPARATION OF AQUEOUS CLEAR SOLUTION
DOSAGE FORMS WITH BILE ACIDS

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ELECTION

I hereby certify that this paper is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231

September 19, 2002

Date of Deposit

Neil P. Sirota

Attorney Name

Signature

38,306

PTO Registration No.

September 19, 2002

Date of Signature

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This paper is being filed in response to the informal copy of an Office Communication, received May 29, 2002, that was communicated in connection with the above-identified application, a copy of which is enclosed herewith, the Interview Summary dated August 9, 2002, and telephone conversations between the Examiner and Applicant's Attorney.

The Examiner first notified Applicant's Attorney of the claim groups of the invention that would be subject to restriction under 35 U.S.C. §120 during a telephone call on January 16, 2002. After conferring with the Applicant, Applicant's Attorney requested written notice of the restriction requirement during a telephone conversation with the Examiner on February 27, 2002. However, Applicant's Attorney did not receive the requested paper. In response to a renewed request by Applicant's Attorney, the Examiner faxed an informal copy of the Office Communication on May 29, 2002 and stated that she would again attempt to have the official Office Communication mailed. The Examiner further indicated that she would attend to restarting the period for reply (MPEP §§ 707.13 and 710.06).

Again, Applicant's Attorney did not receive the official Office Communication. Applicant's Attorney contacted the Examiner on two or three occasions, thereafter to renew Applicant's request for an official copy of the Office Communication bearing an a mailing date and written notice of the reply period pursuant to 37 C.F.R. §1.134. Applicant's Attorney received an Interview Summary dated August 9, 2002 following one of those calls, wherein the Examiner indicated that she would again attempt to send the official Office Communication and would reset the period for a reply accordingly. The Interview Summary also reflects the fact that the Examiner confirmed that the mailing address of Applicant's Attorney.

Nevertheless, Applicant's Attorney did not receive the requested official copy. During a telephone conversation with the Examiner on September 9, 2002, the Examiner suggested that Applicant respond to the informal Office Communication. This paper is being filed in response to that suggestion and to advance prosecution of the instant Application.

The foregoing comments should not be construed to carry any negative implication or complaint regarding the Examiner's conduct. On the contrary, both Applicant and Applicant's Attorney thank the Examiner for her cooperativeness, responsiveness, and diligence throughout these exchanges. The Examiner has displayed exemplary patience and professionalism.

Applicant respectfully requests that the informal Office Communication sent to Applicant's Attorney by facsimile on May 29, 2002, a copy of which is enclosed herewith, be made of record in the instant Application. In view of these unusual circumstances, Applicant additionally respectfully requests that the Examiner expressly acknowledge that Applicant's Response should be considered timely for all purposes. Applicant makes this request on the basis that written notification of the statutory period for reply was never provided pursuant to 37 C.F.R. §1.134. *See e.g.* page 2 of the enclosed informal Office Communication faxed to Applicant's Attorney on May 29, 2002. Thus, since the statutory period never started, it could not have expired. Notwithstanding this basis, Applicant also makes this request on the basis that the Examiner informed Applicant's Attorney that should would reset the period for reply on or about May 29, 2002, which would make timely any response filed on or before October 29, 2002.

The Examiner has alleged that the following groups of claims each constitute a separately patentable invention:

Invention Group I: Claims 1-14;
Invention Group II: Claims 15-22;
Invention Group III: Claims 23-27;
Invention Group IV: Claims 28-36;
Invention Group V: Claims 37-47;
Invention Group VI: Claims 48-77, 81 and 138-147;

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Invention Group VII: Claims 78-80;
Invention Group VIII: Claims 82-87; and 88-96.
Invention Group IX: Claims 97-128.

The Examiner has alleged further that the claims recite the following groups of patentably distinct species:

Species Group I: bile acid, its salts, its derivatives, and a bile acid conjugated with an amine; and
Species Group II: starch conversion product and non-starch polysaccharide.

The Examiner has specifically identified claim 61 as allegedly listing patentably distinct species of bile acid.

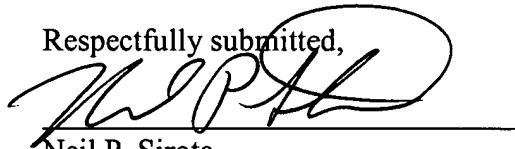
In response, Applicant elects Invention Group VI and elects ursodeoxycholic acid from Species Group I and a starch conversion product from Species Group II.

Applicant believes the foregoing list of Invention Groups accurately reproduces the list presented in the informal Office Communication of May 29, 2002. However, it appears that claims 88-96 and 129-137 have been omitted from the list. Applicant respectfully requests clarification regarding the Invention Group(s) to which these claims have been assigned in order to fully preserve Applicant's rights. Applicant expressly reserves the right pursue non-elected subject matter in one or more divisional application, continuation application, continuation-in-part application, or other application.

Applicants do not believe any fee is due with this submission. Nevertheless, the Commissioner is hereby authorized to deduct any fees required with this submission from Deposit Account No. 02-4377. A duplicate of this page is enclosed.

September 19, 2002

Respectfully submitted,



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Enclosure